

## REMARKS

Claims 24-28 are amended. Please cancel claims 1-23 and 29-42 without prejudice or disclaimer. Applicants reserve the right to file one or more continuation applications claiming the cancelled subject matter. New claims 43-50 are added. Claims 24-28 and 43-50 are currently under examination.

Claims 25-28 have been amended to depend from claim 24. New claims 43-50 are dependent directly or indirectly on claim 24 and are directed to constructs comprising BnSCL1 with a regulatory region, a DNA binding protein, and transgenic plants expressing the constructs. Support for these new claims may be found in claims as originally filed and at page 19, lines 6-8; page 21, line 26 to page 22, line 14; page 32, lines 29 -34; page 34 lines 18-34; page 37, line 31 to page 38, line 13; page 39, lines 7-13; and Example 5.

In response to the Restriction Requirement was sent April 30, 2008, Applicants elected Group XV directed to methods using bnSCL1 – claims 1-4, 11, 13-15, 29, 30, 32 and 34-42, with traverse. Due to an error, group XV was elected rather than group X (directed to the sequence encoding bnSCL1). In response to Applicants' attempts to contact the Examiner and submit an amended response to the restriction requirement, Examiner noted that a search for the subject matter of the claims of group XV had been conducted. In that discussion, the Examiner offered to consider claims directed to the claims of the amended response, provided that the search would not have to be repeated.

Applicants submit with this response an amended claim set corresponding to Group X directed to bnSCL1 which comprises the same subject matter of Group XV and therefore a separate search should not be required.

## SPECIFICATION

The Examiner objected to the specification as it contains embedded hyperlinks. Paragraphs 268, 294, and 303 have been amended to delete the embedded hyperlinks. In view of

the above comments and foregoing amendments, removal of this objection is respectfully requested.

**CLAIM REJECTIONS – 35 U.S.C. § 112, second paragraph**

Claims 3-4, 11, 13, 15 and 29-30 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Claims 3-4, 11, 13, 15 and 29-30 are cancelled without prejudice or disclaimer, therefore the Examiner's rejection is moot.

Applicants note that reference to SEQ ID NO:'s in pending claims 24-28 is made without the use of parentheses.

In view of the above comments, Examiner is requested to withdraw the rejection of claims 3-4, 11, 13, 15 and 29-30 under 35 USC § 112, second paragraph.

**CLAIM REJECTIONS – 35 U.S.C. § 102(b)**

Claims 1-4, 13-15, 34 and 42 are rejected under 35 U.S.C. § 102(b) in view of Collingwood (CA 2407460). A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants have cancelled claims 1-4, 13-15, 34, and 42, thereby rendering this rejection moot, and respectfully request its removal. Additionally, Applicants respectfully assert that this reference is not anticipatory of the pending claims since Collingwood does not disclose bnSCL1 as defined by SEQ ID NO:81 or amino acids 1-358, 1-261, 1-217, or 146-358 of SEQ ID NO:81.

**CLAIM REJECTIONS – 35 U.S.C. § 103**

Claims 1-4, 11, 13-15, 29-30, 32 and 34-42 are rejected under 35 U.S.C. § 103(a) as allegedly obvious over Collingwood (CA 2407460) in view of Ma et al. (*Plant Physiology*, 1995, 109:341-346) and Jenster (*Proc. Natl. Acad. Sci. USA*, 1997, 94:7879-7884). Applicants have

cancelled claims 1-4, 13-15, 34, and 42, thereby rendering this rejection moot, and respectfully request its removal.

To make a *prima facie* case of obviousness, the teachings of the prior art should have suggested the claimed subject matter to the person of ordinary skill in the art, and all the claim limitations must be taught or suggested in the references cited by the Examiner. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000). As articulated by the Supreme Court, a combination is obvious if it is no more than the predictable use of known elements according to their established functions; and there was a reason to combine the known elements. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). Applicants submit that this rejection does not apply to the pending claims.

Collingwood teaches a method of regulating a nucleic acid of interest comprising a first nucleic acid of interest which is a DNA binding domain of zinc finger transcription factors, and a second nucleic acid of interest encoding a fusion protein between a DNA binding domain and a component of a chromatin remodeling complex, a transcriptional repression domain all within a plant, wherein the recruitment factor is a histone deacetylase transcription factor.

Ma teaches that two genes may be introduced into a plant together by cross pollination of individually transformed plants.

Jenster teaches a method of regulating gene expression utilizing a construct comprising histone deacetylase 1 and the GAL4 binding domain.

Claim 24 is directed to an isolated nucleic acid sequence encoding the sequence of BnSCL1, comprising SEQ ID NO: 81. Collingwood does not disclose a nucleic acid sequence encoding BnSCL1, or any sequence comprising SEQ ID NO: 81. Neither Ma nor Jenster remedy this deficiency.

Applicants respectfully submit that there is no teaching, suggestion, or incentive supporting the combination of cited references to produce the claimed invention, nor would "ordinary creativity" provide what is lacking. Therefore, the skilled person would neither be motivated by Collingwood, nor be provided with the information necessary to obtain a nucleic

acid sequence encoding BnSCL1 by Ma or Jenster, in order to achieve the invention as claimed by the amended claims. Applicants therefore submit that claim 24, and claims 25-28 and 43-50 which are dependent on claim 24, are not obvious in view of Collingwood.

The Examiner is respectfully requested to withdraw the rejection of claims 1-4, 13-15, 34 and 42 under 35 USC § 103(a).

### **DOUBLE PATENTING**

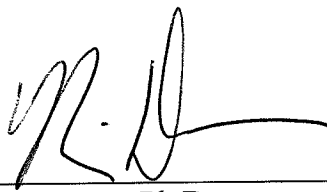
Claims 1-4, 11, 13 and 32 are provisionally rejected under 35 USC § 101 as claiming the same invention as that of claims 1-3, 5, 12, 14 and 33 of copending Application No. 11/067,425. Claims 1-4, 11, 13 and 32 are cancelled without prejudice or disclaimer. Removal of this rejection is respectfully requested.

### **Summary**

In view of the above amendments and remarks, Applicant respectfully requests a Notice of Allowance. If the Examiner believes a telephone conference would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Please charge any additional fees or credit any overpayment to Merchant & Gould P.C., Deposit Account No. 13-2725.

Respectfully submitted,  
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